APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,831	12/12/2001	Mark Andrew Boys	P1364	7488

24739   7590   09/24/2008
CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE, CA 95076

EXAMINER
FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
09/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK ANDREW BOYS

Appeal 2008-2637
Application 10/016,831
Technology Center 3600

Decided: September 24, 2008

Before: MURRIEL E. CRAWFORD, ANTON W. FETTING and
STEVEN D.A. McCARTHY, *Administrative Patent Judges.*

McCARTHY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

1   The Appellant appeals under 35 U.S.C. § 134 (2002) from the final

2 rejection of claims 1-24. We have jurisdiction under 35 U.S.C § 6(b)

3 (2002). We AFFIRM.

1   The claims on appeal relate to a system for managing donations

2   which, according to the Appellant's Specification, permits potential donors

3   to gain access to details of individual persons and families associated with

4   certain disasters and other projects. The Appellant asserts that the system

5   permits donors to make contributions directly and immediately to those

6   particular qualified recipients that meet their own particular criteria for

7   giving. (Specification 15, ll. 13-19). Claim 1 is typical of the claims on

8   appeal:

9
10   1. A system for managing donations comprising:
11   an Internet-connected server accessible by
12   donors using an Internet browser;
13   a data store accessible to the server and
14   storing information about individuals or families,
15   pre-qualified for donations and associated each
16   with a specific account with a financial institution,
17   the account enabling the potential donors to make
18   contributions and the pre-qualified individuals or
19   families to withdraw donated funds; and
20   software executing on the server, enabling
21   donors to obtain specific information about the
22   pre-qualified individuals or families, and also
23   enabling the donors to select one or more of the
24   pre-qualified individuals or families and to make
25   donations to the specific accounts associated with
26   the selected pre-qualified individuals or families.
27

28   ISSUES

29   The issue in this appeal is whether the Appellant has shown that the

30   Examiner erred by:

31   rejecting claims 1-12 under 35 U.S.C. § 112, ¶ 2 (2002)

32   as being indefinite for failing to particular point out and

1   distinctly claim the subject matter which the Appellant regards

2   as the invention;

3   rejecting claims 1-7 and 13-19 under 35 U.S.C. § 103(a)

4   as being unpatentable over Gruber (Publ. US 2002/0029179

5   A1, dated 7 Mar. 2002); and

6   rejecting claims 8-12 and 20-24 under § 103(a) as being

7   unpatentable over Gruber and Cohen (U.S. Patent 6,422,462,

8   issued 23 Jul. 2002).

9   These issues turn, at least in part, on whether the clause "storing

10 information about individuals or families, pre-qualified for donations and

11 associated each with a specific account with a financial institution, the

12 account enabling the potential donors to make contributions and the pre-

13 qualified individuals or families to withdraw donated funds" patentably

14 distinguishes the teachings of Gruber.

15

16   FINDINGS OF FACT

17   The record supports the following findings of fact ("FF") by a

18 preponderance of the evidence.

19   1.   Gruber discloses a computer system established by a

20 fundraising organization or its agent for the purpose of providing

21 information to potential donors, soliciting contributions and receiving

22 pledges and donations. (Gruber 2, ¶ 0033).

23   2.   The system includes a central process server linked to a data

24 storage device. The central process server and the data storage device are

25 used to store information for presentation to potential donors as well as to

26 receive information from potential donors. (Gruber 3, ¶ 0034).

1   3.   A web page in a charitable organization's website includes

2   information concerning the charitable cause. (Gruber 3, ¶ 0037). The initial

3   web page includes a link directing potential donors to a web page in which

4   the potential donor sees virtual plaques honoring previous donors or

5   pledgers. (Gruber 3, ¶ 0038).

6   4.   The page on which the potential donor sees the virtual plaques

7   includes a link directing potential donors to a web page wherein the viewer

8   sees various donation options. (Gruber 3-4, ¶ 0047). Fig. 5 suggests that

9   these various donor options are various recipients to whom the potential

10   donor may contribute.

11   5.   Gruber's system can charge installment payments automatically

12   to a donor's credit card or bank account. (Gruber 4, ¶ 0049).

13

14   PRINCIPLES OF LAW

15   A claim is subject to rejection under section 112, ¶ 2, if the claim fails

16   in "particular pointing out and distinctly claiming the subject matter which

17   the applicant regards as his invention." Compliance with the definiteness

18   requirement of section 112, ¶ 2 ensures adequate notice to those of ordinary

19   skill in the art concerning the scope of issued claims; encourages others to

20   design around the claimed subject matter; and assists others in assessing

21   whether the claimed subject matter is patentable. *United Carbon Co. v.*

22   *Binney & Smith Co.*, 317 U.S. 228, 236 (1942); *General Elec. Co. v.*

23   *Wabash Appliance Corp.*, 304 U.S. 364, 369 (1942). In light of these

24   policies, the language of a claim satisfies § 112, ¶ 2 only if "one skilled in

25   the art would understand the bounds of the claim when read in light of the

26   specification." *Exxon Research & Eng'ring Co. v. United States*, 265 F.3d

1 1371, 1375 (Fed. Cir. 2001). During examination, one may look both to the

2 Specification and to the prior art in determining whether a claim is definite.

3 *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

4   A claim is unpatentable for obviousness under 35 U.S.C. § 103(a) if

5 "the differences between the subject matter sought to be patented and the

6 prior art are such that the subject matter as a whole would have been obvious

7 at the time the invention was made to a person having ordinary skill in the

8 art to which said subject matter pertains." In *Graham v. John Deere Co.*,

9 383 U.S. 1 (1966), the Supreme Court set out factors to be considered in

10 determining whether claimed subject matter would have been obvious:

11
12   Under § 103, the scope and content of the prior art
13   are to be determined; differences between the prior
14   art and the claims at issue are to be ascertained;
15   and the level of ordinary skill in the pertinent art
16   resolved. Against this background, the
17   obviousness or nonobviousness of the subject
18   matter is determined.
19

20 *Id.*, 383 U.S. at 17.

21

22   ANALYSIS

23   *A.   The Rejection of Claims 1-12 Under § 112, ¶ 2*

24   Claim 1 recites "a data store accessible to the server and storing

25 information about individuals or families, pre-qualified for donations and

26 *associated each* with a specific account with a financial institution."

27 (Emphasis added.) The Examiner finds that the term "associated each" is

28 indefinite because the term could refer to donations or to recipients. (Ans.

29 7). We agree with the Appellant (App. Br. 5) that the term would be clear to

1   one of ordinary skill in the art. In particular, we agree with the Appellant

2   (*see* Reply Br. 6) that claim 1 uses the two verbs "pre-qualified" and

3   "associated" conjunctively to refer to the same subject, "individuals or

4   families." Since the verbs "pre-qualified" and "associated" are used

5   conjunctively, it is unlikely that one of ordinary skill in the art would believe

6   that the object of the verb "pre-qualified" is the subject of the verb

7   "associated." Since the word "each" refers reflexively to the subject of the

8   verb "associated," one of ordinary skill in the art would understand "each" to

9   refer to "individuals and families" and not to "donations." On the record

10 before us, the Appellant has shown that the Examiner erred in rejecting

11 independent claim 1 and dependent claims 2-12 under § 112, ¶ 2.

12

13   *B.   The Rejection of Claims 1-3, 5-7, 13-15 and 17-19*
14   *Under § 103(a)*

15   The Appellant argues independent claims 1 and 13 together (App. Br.

16 6) and presents no arguments seeking to show error in the Examiner's

17 rejection of claims 2, 3, 5-7, 14, 15 and 17-19 separate from the arguments

18 presented regarding the rejection of claims 1 and 13 (App. Br. 9). Therefore,

19 we understand that Appellant to have argued claims 1-3, 5-7, 13-15 and 17-

20 19 as a group. We select claim 1 as being representative of the group. 37

21 C.F.R. § 41.37(c)(1)(vii) (2007).

22   The Appellant contends that Gruber does not teach "a data store

23 accessible to the server and storing information about individuals or

24 families, pre-qualified for donations and associated each with a specific

25 account with a financial institution, the account enabling the potential donors

26 to make contributions and the pre-qualified individuals or families to

1   withdraw donated funds." Gruber teaches a data storage device which is

2   accessible to a server and which is used to store information for presentation

3   to potential donors. (FF 2). This information includes information about

4   recipients to whom the potential donor may contribute. (FF 4).

5   Even were we to agree for purposes of this appeal only with the

6   Appellant that Gruber does not teach or suggest a data store accessible to the

7   server and storing information about individuals or families pre-qualified for

8   donations, such a finding would not suffice to show that the Examiner erred

9   in concluding that the subject matter of claim 1 would have been obvious.

10   Nonfunctional descriptive material cannot render nonobvious an invention

11   that otherwise would have been obvious. *In re Ngai*, 367 F.3d 1336, 1339

12   (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)

13   (when descriptive material is not functionally related to the substrate, the

14   descriptive material will not distinguish the invention from the prior art in

15   terms of patentability).

16   Here, the descriptive information concerning the pre-qualified

17   individuals and families recited in claim 1 is not functionally related to the

18   data store. Unlike executable code which may define the tasks performed by

19   a general purpose computer with which the code is associated and thereby

20   transform the general purpose computer into a machine dedicated to those

21   particular tasks, data or information stored by a data store does not alter the

22   fundamental structure of the data store itself. The Appellant has not

23   identified how the difference between storing information concerning

24   charitable organizations and their activities as taught in Gruber and storing

25   information concerning pre-qualified individuals and families as recited in

1   claim 1 alters the function performed by the data store.[1] Therefore, this

2   difference does not distinguish the subject matter of claim 1 from the

3   teachings of Gruber in terms of patentability.

4   Likewise, the recitation in claim 1 of software executing on the server

5   enabling donors to obtain specific information about the pre-qualified

6   individuals or families does not distinguish the subject matter of claim 1 in

7   terms of patentability. "[E]xpressions relating the apparatus to contents

8   thereof during an intended operation are of no significance in determining

9   patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666,

10   667 (Bd. App. 1969). Furthermore, "inclusion of material or article worked

11   upon by a structure being claimed does not impart patentability to the

12   claims." *In re Otto*, 312 F.2d 937, 940 (CCPA 1963). As discussed in the

13   preceding paragraphs, the information about individuals or families pre-

14   qualified for donations is content on which the system operates. The

15   Appellant has not identified how the particular nature of that information

16   alters the structure of the system. Hence, the recitation cannot impart

17   patentability to claim 1.

18   Claim 1 also recites software executing on the server enabling donors

19   to make donations to the specific accounts associated with the selected pre-

20   qualified individuals or families. Each of these accounts is held by a

21   financial institution. Each of these accounts enables potential donors to

---

[1]   The Appellant contends that "[t]here is absolutely no teaching or suggestion in the art of Gruber to teach pre-qualifying individuals . . . ." (App. Br. 7). Claim 1 does not recite a method step of pre-qualifying individuals or families but rather a data store storing information about pre-qualified individuals or families.

1 make contributions and the pre-qualified individuals or families to withdraw

2 donated funds.

3   We agree with the Examiner (Ans. 8) that claim 1 by its own terms

4 does not exclude a system in which donations or withdrawals pass through

5 an intermediary such as a charitable organization. A claim under

6 examination is given its broadest reasonable interpretation consistent with

7 the underlying specification when determining whether the subject matter of

8 the claim is either anticipated or obvious. *In re American Acad. of Science*

9 *Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Limitations not expressed

10 in the language of a claim cannot be imported from the specification. *E-*

11 *Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

12   Gruber teaches a system established by a fundraising organization.

13 (FF 1). Since Gruber's system provides donors with various donor options,

14 that is, various recipients to whom the donor may contribute (FF 4), it would

15 have been obvious to one of ordinary skill in the art to set up separate

16 accounts, each account associated with one of the donor options, so as to

17 prevent commingling of funds. We agree with the Examiner (Ans. 8-9), that

18 it would have been obvious for the fundraising organization to set up these

19 accounts with financial organizations since one of ordinary skill in the art

20 would have recognized that financial institutions would have greater

21 expertise than a fundraising organization in holding such accounts.

22   Claim 1 does not recite that the accounts must enable potential donors

23 to make contributions directly to such an account or enable pre-qualified

24 individuals or families to withdraw funds directly from such an account.

25 Given its broadest reasonable interpretation, the language of claim 1

26 encompasses accounts which enable potential donors to make contributions

1   in the sense that the accounts are available to receive donations via a

2   fundraising organization which accepts the contributions from the donors.

3   Likewise, given its broadest reasonable interpretation, the language of claim

4   1 encompasses accounts which enable pre-qualified individuals or families

5   to withdraw money in the sense that the accounts provide the fundraising

6   organization access to the proceeds of the contributions when pre-qualified

7   individuals or families seek to withdraw funds from the fundraising

8   organization. Although the Appellant's Specification asserts that "[a]n

9   important object of the invention is to make possible direct contribution,

10 wherein financial aid is passed through, without any monies being delayed,

11 polled, or retained in the name of the host server system" (Specification 8, ll.

12 11-14), we cannot import this object from the Specification in order to

13 distinguish the subject matter of claim 1 from the teachings of Gruber.

14   On the record before us, the Appellant has not shown that the

15 Examiner erred in rejecting claims 1-3, 5-7, 13-15 and 17-19 under § 103(a)

16 as being unpatentable over Gruber.

17

18   C.   *The Rejection of Claims 4 and 16 Under § 103(a)*

19   The Appellant contends that Gruber does not teach or suggest that a

20 donation made by a donor to an account associated with a pre-qualified

21 individual or family results in a withdrawal of the donated amount by the

22 individual or family from an account associated with the donor. (App. Br.

23 9). We disagree. Gruber's system can charge installment payments

24 automatically to a donor's bank account. (FF 5). Charging an installment

25 payment for a donation made by a donor via a fundraising organization to

26 the account associated with the pre-qualified individual or family would

1   result in a withdrawal from the bank account associated with the donor. On

2   the record before us, the Appellant has not shown that the Examiner erred in

3   rejecting claims 4 and 16 under § 103(a) as being unpatentable over Gruber.

4

5   *D.   The Rejection of Claims 8-12 and 20-24 Under § 103(a)*

6   The Appellant presents no argument suggesting that claims 8-12 and

7   20-24 might be patentable if claim 1 were not. (*See* App. Br. 9). In view of

8   our affirmance of the rejection of claim 1 under § 103(a), we sustain the

9   rejection of claims 8-12 and 20-24 under § 103(a).

10

11   CONCLUSIONS

12   On the record before us, the Appellant has shown that the Examiner

13   erred in rejecting claims 1-12 under § 112, ¶ 2. The Appellant has not

14   shown that the Examiner erred in rejecting claims 1-7 and 13-20 under

15   § 103(a) as being unpatentable over Gruber or in rejecting claims 8-12 and

16   20-24 under § 103(a) as being unpatentable over Gruber and Cohen.

17

18   DECISION

19   We AFFIRM the rejections of claims 1-24.

20   No time period for taking any subsequent action in connection with

21   this appeal may be extended under 37 C.F.R. § 1.136(a) (2007). *See* 37

22   C.F.R. § 1.136(a)(1)(iv) (2007).

23

24   <u>AFFIRMED</u>

25

26

1

2

3
4
5
6
7
8
9
10
11 LV:
12
13
14
15
16
17
18
19
20 CENTRAL COAST PATENT AGENCY, INC.
21 3 HANGAR WAY SUITE D
22 WATSONVILLE, CA 95076